

REMARKS

This is in response to the Office Action dated March 15, 2004, and the references cited therewith.

No claims are amended, no claims are canceled, and no claims are added. The Examiner has withdrawn claims 1-26 and as a result, claims 27-56 remain pending in this application.

The Brief Description of the Drawings is amended to further clarify the disclosure. It is believed that the changes do not introduce new matter. Entry of the amendment is respectfully requested.

Affirmation of Election

Restriction to one of the following claims was required:

1. Claims 1-13, drawn to an MRI-guided method for performing an invasive procedure, classified in class 600, subclass 411.
2. Claims 27-56, drawn to a stereotactic apparatus for inserting a probe into a region, classified in class 606, subclass 130.

Applicant affirms the election to prosecute the invention of Group II, claims 27-56. In addition, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected subject matter.

§112 Rejection of the Claims

Claims 49 and 50 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant respectfully traverses the rejection and submits that claim 49 and claim 50 are sufficiently clear to one of ordinary skill in the art in light of the disclosure, the prior art and the claim interpretation of one of ordinary skill in the art. As noted by M.P.E.P. § 2111.03, the open ended transition phrase ("comprising") does not exclude additional, un-recited elements or method steps. Accordingly, the phrase of claim 49 does not exclude additional or other materials. Reconsideration and allowance of claims 49 and 50 is respectfully requested.

§102 Rejection of the Claims

Claims 27-43, 48 and 51-56 were rejected under 35 USC § 102(e) as being anticipated by Siczek et al.

Applicant respectfully traverses and submits that *prima facie* anticipation has not been established. For example, Applicant is unable to find, in Siczek, a teaching of a stage coupled to the first compression surface and the second compression surface and adapted to rotate on a second axis substantially orthogonal to the first axis, as recited in claim 27. The Office Action refers to "stage (130) with respect to supporting surface (120)" however, Applicant is unable to discern the recited element in the figures and is unable to find such a disclosure in the detailed description of Siczek. Applicant is also unable to find, in Siczek, a description of item 130 as a "stage."

In addition, Applicant is unable to find, in Siczek, a teaching of a rotatable platform having a first rotational axis, as recited in claim 51. In addition, Applicant is unable to find, in Siczek, a teaching of a guide, having a guide axis, coupled to the platform and aligned to direct a probe along the guide axis into a region disposed between the first rigid structure and the second rigid structure, as recited in claim 51. Applicant submits that Siczek does not teach the identical invention shown in as complete detail as recited in the claim.

As to dependent claims 28-43, 48 and 52-56, Applicant respectfully submits that each recites additional elements beyond that of the independent claim from which each depends. For at least the reasons noted above, Applicant respectfully submits that *prima facie* anticipation has not been established.

Reconsideration and allowance of claims 27-43, 48 and 51-56 is respectfully requested.

§103 Rejection of the Claims

Claim 44 was rejected under 35 USC § 103(a) as being unpatentable over Siczek et al. in view of Russell et al.

Applicant respectfully traverses the rejection and submits that proper *prima facie* obviousness has not been established because, *inter alia*, the proposed combination is improper.

The Office Action has not adequately supported the selection and combination of the Siczek and Russell to render obvious that which the Applicant has described. In contrast, the Office Action sets forth a conclusory statement regarding providing "less restricted access to the target region and to avoid contamination of the compression plate" which does not adequately address the issue of motivation to combine. Applicant is unable to find, in the proposed combination, support for the motivation asserted in the Office Action.

The factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The Office Action does not appear to include the requisite findings as to motivation (based on evidence of record), and also does not explain the reasoning by which the findings are deemed to support the conclusion of obviousness.

For these and other reasons, Applicant respectfully requests reconsideration and allowance of claim 44.

Claims 45-47 were rejected under 35 USC § 103(a) as being unpatentable over Siczek et al. in view of Russell et al. and further in view of Chakeres.

Applicant respectfully traverses the rejection and submits that proper *prima facie* obviousness has not been established because, *inter alia*, the proposed combination of Siczek, Russell and Chakeres is improper.

The Office Action has not adequately supported the selection and combination of the Siczek, Russell and Chakeres to render obvious that which the Applicant has described. In contrast, the Office Action sets forth a conclusory statement regarding providing "more accurate needle guidance while maintaining a sterile procedure" which does not adequately address the

issue of motivation to combine. Applicant is unable to find, in the proposed combination, support for the motivation asserted in the Office Action.

The Office Action does not appear to include the requisite findings as to motivation (based on evidence of record), and also does not explain the reasoning by which the findings are deemed to support the conclusion of obviousness.

For these and other reasons, Applicant respectfully requests reconsideration and allowance of claims 45-47.

Claims 49 and 50 were rejected under 35 USC § 103(a) as being unpatentable over Siczek et al. in view of Panetta et al.

Applicant respectfully traverses the rejection and submits that *prima facie* obviousness has not been established. For example, Applicant submits that the proposed combination of Siczek and Panetta is improper.

The Office Action has not adequately supported the selection and combination of the Siczek, Russell and Chakeres to render obvious that which the Applicant has described. In contrast, the Office Action sets forth a conclusory statement regarding "to use plastic materials in the biopsy system of Siczek et al. as taught by Panetta et al. as a cheaper, well known expedient in the art" which does not adequately address the issue of motivation to combine. Applicant is unable to find, in the proposed combination, support for the motivation asserted in the Office Action.

The Office Action does not appear to include the requisite findings as to motivation (based on evidence of record), and also does not explain the reasoning by which the findings are deemed to support the conclusion of obviousness.

For these and other reasons, Applicant respectfully requests reconsideration and allowance of claims 49 and 50.

Conclusion

Applicant respectfully submits that the pending claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6911 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

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Date June 15, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16th day of June, 2004.



Name



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